

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

APPELLANT'S BRIEF AND JOINT APPENDIX

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19,091

ARRIVALS, LTD., Appellant,

v.

DAVID L. LADD, Commissioner of Patents, Appellee.

Appeal from the Final Judgment of the United States District
Court for the District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

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STATEMENT OF QUESTIONS PRESENTED

The questions are:

1. Whether appellant's trademark 2ND DEBUT creating the commercial impression of the older woman seeking her second attempt at beauty, so differs from the reference LE DEBUT meaning introduction of a young lady into society that there is no likelihood of confusion.
2. Whether the Patent Office, after allowing trademark registrations of DEBUTANTE and DEBUTETTE over LE DEBUT can fairly deny appellant's registration of 2ND DEBUT.

INDEX

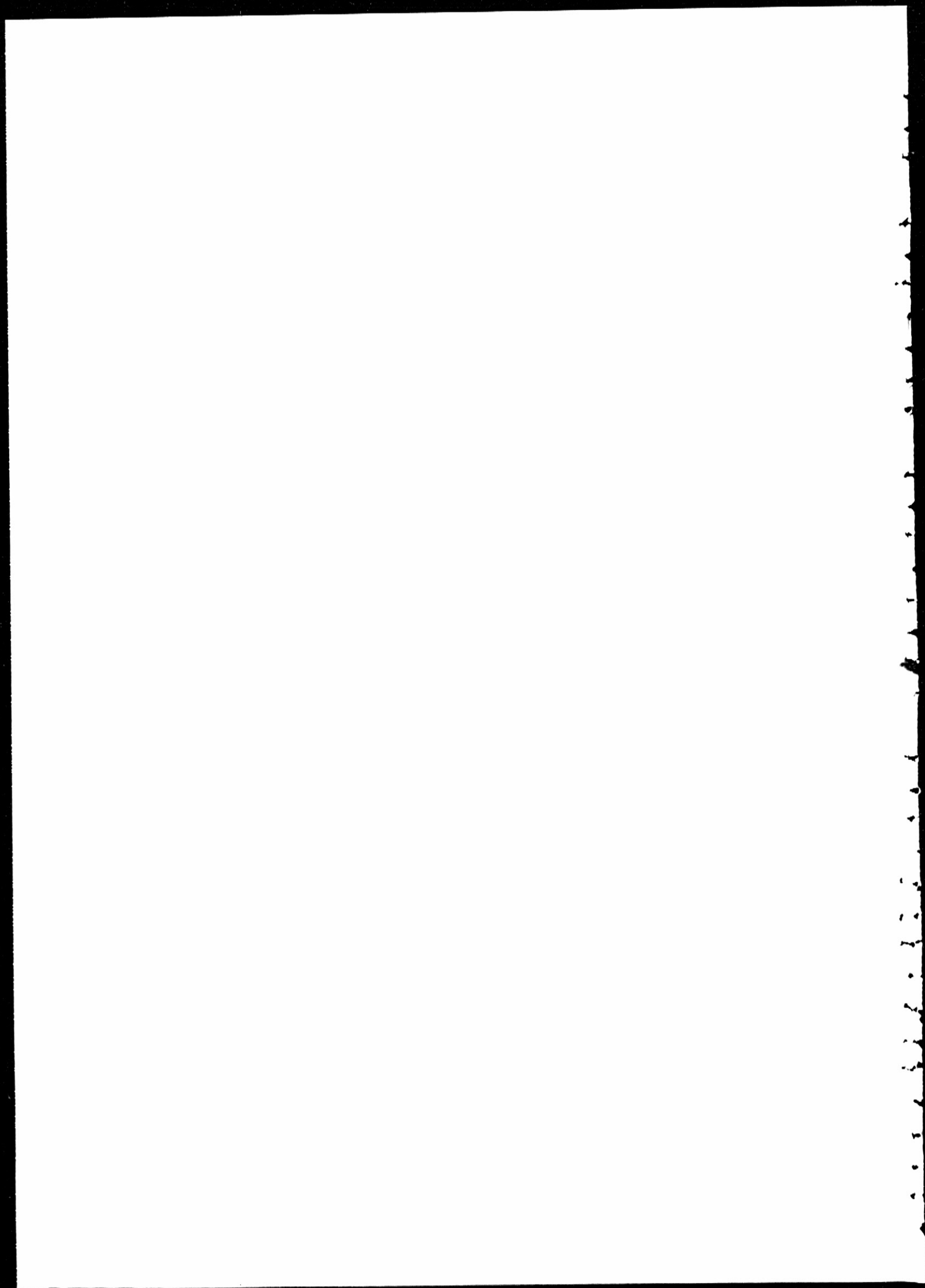
	Page
Statement of Questions Presented.	
Jurisdictional Statement	1
Statement of the Case	2
The Statute Involved	2
Statement of Points on Which Appellant Intends to Rely On This Appeal	3
Summary of Argument	4
Argument:	
Appellant's Record is Thorough and Convincing That the Trademark 2ND DEBUT Created the Distinct and Different Commercial Impression of the Mature Woman Seeking Her Second Attempt at Beauty	4
Over the Last Five Years Appellant's Sale and Ad- vertising of 2ND DEBUT Cosmetics Has Been Substantial, So That the Trademark 2ND DEBUT is Known to the Purchasing Public	6
The Registrations of LE DEBUT and LE DEBUT NOIR Cited by the Patent Office Provide Such a Different Commercial Impression to the Cosmetics' Buyer That There Is No Likelihood of Confusion..	7
The Authorities Hold That a New Trademark May Contain in Its Entirety an Old Trademark if the New Trademark Presents Such a Different Mean- ing That There Is No Likelihood of Confusion	8
After the Registration of the References for LE DEBUT and LE DEBUT NOIR, the Patent Office Allowed Registrations for DEBUTANTE, DEBU- TETTE, MISS DEBUTANTE and Other Marks Which So Limit the References That They Should Not Be Cited to Prevent Appellant's Registration of 2ND DEBUT	11
The Authorities Hold That the Courts May Consider the Registrations of Third Persons to Determine Whether LE DEBUT and LE DEBUT NOIR Are Weak Marks and Too Narrow to Prevent the Reg- istration of Appellant's Mark	12
Conclusion	13

	Page
TABLE OF CASES	
American Home Foods, Inc. v. North American Corp., 114 USPQ 132	10
*Clayton Mark & Co. v. Keystone Co., 47 CCPA 1071, 279 F. 2d 279	10
Cluett Peabody & Co. v. Savatux Facing Company, 47 CCPA 944, 277 F. 2d 944	10
Conde Nast Publications, Inc. v. American Greetings Corp., 136 USPQ 669 (Bd.)	12
Cooperative Quality Marketing, Inc. v. Dean Milk Co., 314 F. 2d 552 (CCPA)	12
*Ford Motor Co. v. Partridge, 58 App. D.C. 195, 26 F. 2d 567	8
*Gold Seal Co. v. Marzall, 100 Fed. Sup. 185 (DC DC) Goodall-Sanford, Inc. v. Tropical Co., 47 CCPA 823, 275 F. 2d 736 (CCPA)	8 12
*Intercontinental Mfg. Co. v. Continental Motors Corp., 43 CCPA 841, 230 F. 2d 621 (CCPA)	9
J. P. Stevens & Co. v. Farbenfabriken, 124 USPQ 432 (Bd.)	10
Lever Bros. Co. v. Diversey Corp., 91 USPQ 251 (Bd.)	10
*Lever Brothers Company v. Thrift-D-Lux Cleaners, 114 USPQ 82 (CP)	9
*McGraw Hill Pub. Co. v. American Aviation Assn., Inc., 73 App. D.C. 131, 117 F. 2d 293	8
Pet Milk Co. v. Knudsen Creamery Co., 138 USPQ 532 (Bd.)	10
Purex Corp. v. United Drug Co., 67 F. 2d 918 (CCPA)	10
The Crown Overall Mfg. Co. v. Desmonds, 37 CCPA 1118, 182 F. 2d 645	10
Time, Inc. v. Ulten Publications, 96 F. 2d 164 (CA 2)	10
Time, Inc. v. Viobin Corp., 40 Fed. Sup. 249 (DC Ill.) 128 F. 2d 860 (CA 7)	10
United Drug Company v. The Mercirex Co., 37 CCPA 1013, 182 F. 2d 222	10
Wise v. Bristol-Myers Co., 94 USPQ 327 (DC NY) ..	10

* Cases or authorities chiefly relied upon are marked by asterisks.

INDEX TO JOINT APPENDIX

	Page
Complaint to Compel the Issuance of a Trademark Registration	1
Answer to Complaint	5
Excerpts from Transcript of Record:	
Testimony of Norman J. Phelps	7
Opinion	11
Order of September 25, 1964	13
Notice of Appeal	13
Plaintiff-Appellant's Exhibit No. 1:	
Page 1 of Plaintiff's Application as amended	14
Page 3 of the drawing of the application	15
Pages 25 and 26—Examiner's Statement	16
Pages 30, 31, and 32—Decision of the Board	18
Tabs A-F: Trademark Registrations:	
No. 200,218	21
No. 200,677	22
No. 236,110	23
No. 236,111	24
No. 420,498	25
No. 432,820	26
Plaintiff's Exhibit No. 7:	
Trademark Registrations:	
No. 640,485	27
No. 506,568	28
No. 297,827	27



IN THE
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No. 19,091

ARRIVALS, LTD., *Appellant*,

v.

DAVID L. LADD, Commissioner of Patents, *Appellee*.

Appeal from the Final Judgment of the United States District
Court for the District of Columbia

PLAINTIFF-APPELLANT'S BRIEF ON APPEAL

JURISDICTIONAL STATEMENT

This is a suit filed in the District Court of the United States for the District of Columbia under 15 U.S.C. 1071 as alleged in paragraph 1 of the complaint, and admitted by the solicitor for the United States Patent Office in paragraph 1 of the answer. This is an appeal duly taken from a decision of the District Court for the District of Columbia.

STATEMENT OF THE CASE

This is an action to review the *exparte* ruling of the Patent Office denying appellant's application for registration of the trademark 2ND DEBUT for lotion, Serial No. 95,865 on the ground that it was confusingly similar to prior registrations of LE DEBUT and LE DEBUT NOIR, Registration Nos. 200,218, 200,677, 420,498, 432,820, 236,110 and 236,111 by Richard Hudnut. There was no evidence in this case of confusion or likelihood of confusion offered by the Patent Office, so that the ruling is merely the opinion of the Examiner and the District Court.

Appellant responded to the United States Patent Office showing the differences between appellant's trademark and those of the references cited by the Examiner and also pointing out that after said references, registrations were issued as follows: DEBUTANTE, Registration Nos. 297,827 and 506,568, MISS DEBUTANTE, Registration No. 688,456 and DEBUTETTE, Registration No. 640,485, all to Daggett & Ramsdell, Inc., DEBONAIR, Registration No. 538,612, DEBMETICS, Registration No. 411,422, DEBONY, Registration No. 521,933, and DEB-U-CURL, Registration No. 700,664.

When the Patent Office refused to grant appellant's application for registration of 2ND DEBUT, appellant filed a complaint in the District Court of the United States for the District of Columbia. This complaint was dismissed, and appellant filed this appeal to this Honorable Court.

THE STATUTE INVOLVED

Involved is 15 U.S.C. 1071, which provides:

"Whenever a person authorized by section 21(a) hereof to appeal to the United States Court of Customs and Patent Appeals is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said Court of Customs and Patent Appeals, have

remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 21(a). The court may adjudge that an applicant is entitled to a registration upon the application involved."

**STATEMENT OF POINTS ON WHICH APPELLANT
INTENDS TO RELY ON THIS APPEAL**

In accordance with Rule 15 of this Court, appellant respectfully states that it intends to rely on the following points in this appeal:

1. That appellant's trademark 2ND DEBUT creates the commercial impression of the older woman seeking her second attempt at beauty and so differs from the reference LE DEBUT, meaning the introduction of a young lady into society, that there is no likelihood of confusion.
2. The dominant and first word 2ND so characterizes 2ND DEBUT that its meaning is so changed from the reference LE DEBUT as to eliminate any likelihood of confusion.
3. In the cases where INTERCONTINENTAL and CONTINENTAL, and THRIFT-D-LUX and LUX were held not confusingly similar, even though the first contained all of the second because different meanings were created, such holdings are pertinent to the case at bar because 2ND DEBUT differs in psychological impact from LE DEBUT.
4. After the Patent Office granted registration of LE DEBUT cited, it also allowed registration to competitors of DEBUTANTE and DEBUTETTE. This so limits the scope of LE DEBUT that it should not be a bar to prevent appellant's registration of 2ND DEBUT.
5. There has been no confusion in over four years of concurrent use of 2ND DEBUT and LE DEBUT, so that there is no reasonable likelihood of confusion in the future, and no realistic basis to deny appellant's registration of 2ND DEBUT.

SUMMARY OF ARGUMENT

Appellant's lotion was created for the mature woman seeking her second approach to beauty. The trademark 2ND DEBUT was aptly phrased for this product and suggested the meaning of the older woman in her second quest for beauty. 2ND DEBUT presents a new commercial impression specially directed toward this product and its mature purchasers.

This differs substantially from LE DEBUT which conveys the meaning of the young girl's one and only introduction into society.

Because of these differences in meaning there has been no actual confusion in fact in over 5 years between LE DEBUT and 2ND DEBUT. Even academically it is submitted that there is no basis for any holding of likelihood of confusion.

After the registration of the references LE DEBUT and LE DEBUT NOIR, registrations of DEBUTANTE and other DEBUT marks were granted to competing companies. These registrations are closer to LE DEBUT than appellant's mark. If DEBUTANTE is granted registration over LE DEBUT, then appellant, in all fairness, is entitled to registration of 2ND DEBUT.

ARGUMENT

Appellant's Record Is Thorough and Convincing That the Trademark 2ND DEBUT Created the Distinct and Different Commercial Impression of the Mature Woman Seeking Her Second Attempt at Beauty

Appellant's lotion was created for the older woman seeking her second approach to beauty. 2ND DEBUT was chosen as an appropriate trademark for such a product. Appellant's advertisements show the picture of a mature woman, with the headline "2ND DEBUT for Mother" (Pl. Ex. 5). The trademark 2ND DEBUT was adopted to

emphasize the older woman, and presented a distinct commercial impression.

Appellant's witness was Norman J. Phelps, an advertising man, who has specialized in cosmetics for the last forty-one years (A 7). He has represented such famous clients as Tabu, Maybelline, Lady Esther (A 7).

He has been with appellant, Arrivals, Ltd., since its inception five years ago and created at that time, in 1960, the trademark 2ND DEBUT (A 7), which is used on appellant's lotion and other cosmetics and is in evidence as Plaintiff's Exhibits 2, 3 and 4 (A 8).

Mr. Phelps created a distinct and different motif for advertising 2ND DEBUT cosmetics directed only to the mature woman.

The advertisements as shown by Plaintiff's Exhibit 5 show pictures of the mature woman with the headline 2ND DEBUT For Mother. "The basic promotional idea of the motif" testified Mr. Phelps "is to suggest to the older woman through the use of this product she might recapture some of the appearance she had during her youth" (A 9). These advertisements are, of course, not directed to the young girl making her introduction to society, but "are directed solely to the older woman" (A 9). In the advertisements in Plaintiff's Exhibit 5 is the suggestion that 2ND DEBUT lotion is so beneficial to the face and neck that users will look younger again and gain the effect of face lifting at home without surgery.

This motif creates a new and distinct commercial impression and psychological impact, not before associated with any previous cosmetics.

**Over the Last Five Years Appellant's Sale and Advertising of
2ND DEBUT Cosmetics Has Been Substantial, So That
the Trademark 2ND DEBUT Is Known to the Purchasing
Public**

Appellant has sold its 2ND DEBUT lotion and other cosmetics since April 12, 1960, as shown by the packages and bottles in evidence as Plaintiff's Exhibits 2, 3 and 4 "in department stores, chain drug stores and specialty shops" (A 8), including such famous stores as Marshall Field & Company in Chicago, Bonwit Teller, Thrifty Drug (A 8). Appellant's trademark 2ND DEBUT is known to the purchasing public (A 8).

Appellant's advertising, of which Plaintiff's Exhibit 5 is typical, has been extensive and has appeared in metropolitan newspapers, such as the Chicago Tribune, Los Angeles Times, Kansas City Star, Dallas News, St. Louis Post Dispatch (A 9).

Over the period of five years, there has never been any confusion with reference to 2ND DEBUT cosmetics (A 10). No one has ever attacked or protested appellant's use of the trademark 2ND DEBUT, and no orders have ever been received or filled by appellant for any other trademarked products (A 10). Mr. Phelps testified that he had never heard of any confusion (A 11).

The Patent Office record in evidence as Plaintiff's Exhibit 1 and the references cited by the Patent Office in evidence as Defendant's Exhibit 1 show that there was no prior registration of the trademark 2ND DEBUT for cosmetics.

**The Registrations of LE DEBUT and LE DEBUT NOIR Cited
by the Patent Office Provide Such a Different Commercial
Impression to the Cosmetics' Buyer That There Is No Like-
lihood of Confusion**

These LE DEBUT and LE DEBUT NOIR references are referred to in the Patent Office record, Plaintiff's Exhibit 1, and in Defendant's Exhibit 1.

Appellant's typical advertisements show that the motif behind appellant's 2ND DEBUT lotion is the older woman seeking her second chance at beauty. These advertisements are in evidence as Plaintiff's Exhibit 5. These advertisements submit the motif of the older, but still beautiful, woman helping preserve her beauty with the use of appellant's 2ND DEBUT lotion.

This motif emphasizes the 2ND in 2ND DEBUT so that the dominant commercial impression is that of the second chance at beauty.

This is an entirely different meaning than that conveyed by LE DEBUT, which suggests the first introduction of a young lady into society. LE DEBUT NOIR creates the impression of a young lady being first introduced in public dressed in black. These references convey the commercial impression of the young lady coming out for the first time in society.

There is a difference in the words of the trademarks. LE DEBUT means *THE* DEBUT and, of course, the original entrance of the young lady into society. There is no such thing as a 2ND DEBUT, before appellant's creation of it. 2ND DEBUT is a play on words and when used on lotion, it suggests an older person seeking her second attempt at beauty.

The psychological impact of LE DEBUT is the introduction of a young lady to society. The psychological impact of 2ND DEBUT is the older woman seeking her second chance at beauty.

The commercial impressions are so different that the concurrent use of the two trademarks would not be likely to cause confusion. There never has been any confusion in the past between appellant's 2ND DEBUT products and those of the references and none is likely to occur in the future.

Appellant has found that there are many authorities sustaining the position that where the commercial impressions are different, that the mark is allowable over the reference.

The Authorities Hold That a New Trademark May Contain in Its Entirety An Old Trademark If the New Trademark Presents Such a Different Meaning That There Is No Likelihood of Confusion

This Court has ruled on this question in the case of *Ford Motor Co. v. Partridge*, 58 App. D.C. 195, 26 F. 2d 567 in dismissing a petition for cancellation of a trademark registration and holding WARFORD for automobile transmissions not confusingly similar to FORD for automobiles. This Court held WARFORD was a registrable trademark even though WARFORD contained the entire word FORD and even though the WARFORD transmissions were sold for use in FORD cars. Applying this case to the case at bar, 2ND DEBUT differs from LE DEBUT by eliminating LE and using 2ND. This is even more differentiating than using the prefix WAR.

Another precedent of this Court is the case of *McGraw Hill Pub. Co. v. American Aviation Assn., Inc.*, 73 App. D.C. 131, 117 F. 2d 293 where AMERICAN AVIATION was held not confusingly similar to AVIATION.

In a D.C. D.C. case, GOLD SEAL was held not confusingly similar to GOLD DUST in a contested opposition in *Gold Seal Co. v. Marzall*, 100 Fed. Sup. 185.

The above cited *American Aviation* case, *supra*, was the basis for a ruling that the trademark INTERCONTINEN-

TAL was not confusingly similar to CONTINENTAL for machinery in *Intercontinental Mfg. Co. v. Continental Motors Corp.*, 43 CCPA 841, 230 F. 2d 621. In this case, the CCPA reversed the Patent Office in an opposition, and said:

"In our opinion the instant mark INTERCONTINENTAL would not be regarded merely as appellee's mark CONTINENTAL with two syllables added, but as a new word having such a different meaning, sound and appearance as to preclude the likelihood of confusion."

The Court's attention is respectfully directed to the point that the foregoing cases were contested cases, namely oppositions and cancellations. The case at bar is an ex parte rejection and is all the more deserving of being passed to publication. Once it is published any one claiming rights will have the right to oppose. The owner of the references has never attacked appellant and it is appellant's opinion that it will not oppose appellant in an opposition, and if it does that, it would lose.

Where the new trademark, such as appellant's trademark creates a distinctly dissimilar impression from the prior registration, the new mark has been held to be deserving of registration. This was clearly stated by the Commissioner of Patents in holding THRIFT-D-LUX should be granted registration over LUX in *Lever Brothers Company v. Thrift-D-Lux Cleaners*, 114 USPQ 82:

"Opposer's contention is that because applicant's mark contains the entire mark of opposer, confusion is likely. It does not automatically follow that confusion is likely where a newcomer adopts and uses a composite mark which contains a registered mark. The probable commercial impression and mental association are controlling."

SUMARK was granted registration and held not confusingly similar to MARK on plumbing supplies, although

it included all of the opposer's trademark MARK, in *Clayton Mark & Co. v. Keystone Co.*, 47 CCPA 1071, 279 F. 2d 279. The CCPA said that the differences outweighed the similarities; that the added matter was not descriptive and was distinctive and differentiated SUMARK from MARK. In the case at bar, 2ND is not descriptive and is more than merely added matter. It changes the whole meaning of the mark.

There are many decisions which have allowed registration to the second mark because it had different associations and created an entirely different psychological impact on the purchasing public. In these decisions registration was granted to 3 CHEFS over CHEF by the Board in *American Home Foods, Inc. v. North American Corp.*, 114 USPQ 132; FLEXI-CROWN over CROWN in *The Crown Overall Mfg. Co. v. Desmonds*, 37 CCPA 1118, 182 F. 2d 645; CUPRAMA over RAMA by the Board in *J. P. Stevens & Co. v. Farbenfabriken*, 124 USPQ 432; D-LUXE over DIVOLUXE by the Board in *Lever Bros. Co. v. Diversey Corp.*, 91 USPQ 251; MERCIREX over REX in *United Drug Company v. The Mercirex Co.*, 37 CCPA 1013, 182 F. 2d 222; PUREX over REX in *Purex Corp. v. United Drug Co.*, by the CCPA in 67 F. 2d 918; PETITE over PET by the Board in *Pet Milk Co. v. Knudsen Creamery Co.*, 138 USPQ 532; and PROM PLAID over PLAID in *Cluett Peabody & Co. v. Savatux Facing Company*, 47 CCPA 944, 277 F. 2d 944.

Other Federal Courts have held LIFE OF WHEAT and LIFE not confusingly similar in *Time, Inc. v. Viobin Corp.*, 40 Fed. Sup. 249 (D.C. Ill.), and affirmed by the C.A. 7 in 128 F. 2d 860. BUFF and BUFFERIN were held not confusingly similar in *Wise v. Bristol-Myers Co.*, 94 USPQ 327 by the D.C. N.Y., as were MOVIE LIFE and LIFE by the C.A. 2 in *Time, Inc. v. Ulten Publications*, 96 F. 2d 164.

In all these cases, the added matter, like appellant's 2ND changed the character of the mark so as to give it distinctive and different meaning, and prevent any likelihood of confusion.

After the Registration of the References for LE DEBUT and LE DEBUT NOIR, the Patent Office Allowed Registrations for DEBUTANTE, DEBUTETTE, MISS DEBUTANTE and Other Marks Which So Limit the References That They Should Not Be Cited to Prevent Appellant's Registration of 2ND DEBUT

After the registration of the references for LE DEBUT and LE DEBUT NOIR to Richard Hudnut, registrations of DEBUTANTE, DEBUTETTE and MISS DEBUTANTE were allowed to a competing cosmetic house—namely, Daggett & Ramsdell. These registrations are No. 297,827 of October 4, 1932 and No. 506,568 of February 8, 1949 for DEBUTANTE, No. 688,456 of November 17, 1959 for MISS DEBUTANTE, and No. 640,485 of January 22, 1957 for DEBUTETTE (A 10, Plaintiff's Exhibit 7). DEBUTANTE is submitted as closer to LE DEBUT than 2ND DEBUT.

Other registrations to other cosmetic users included DEBMETICS, No. 441,422 of November 23, 1948; DEBONAIRE, No. 538,612 of February 27, 1951; DEBONY, No. 521,933 of March 7, 1950, and DEB-U-CURL, No. 700,664 of July 5, 1960 (Plaintiff's Exhibit 7). It is urged that 2ND DEBUT is not as close to LE DEBUT as DEB-U-CURL. All these registrations are in evidence as Plaintiff's Exhibit 7.

It is to be noted that Richard Hudnut either failed to oppose DEBUTANTE, DEB-U-CURL and the other marks, or lost the oppositions.

At any rate, none of these marks were considered to be confusingly similar to Richard Hudnut's LE DEBUT and were granted registration. There is no record of any litigation or claims of confusion between any of these registered trademarks.

Under these circumstances, it would seem only fair to allow registration of appellant's trademark. Whether the references LE DEBUT and LE DEBUT NOIR were con-

sidered weak marks to allow registration of DEBUTANTE thereover, or whether the Patent Office considered DEBUTANTE sufficiently different from LE DEBUT and LE DEBUT NOIR to grant its registration, yet the fact remains that appellant should be accorded the same treatment under the law with the granting of registration of 2ND DEBUT.

The Authorities Hold That the Courts May Consider the Registrations of Third Persons to Determine Whether LE DEBUT and LE DEBUT NOIR Are Weak Marks and Too Narrow to Prevent the Registration of Appellant's Mark

In *Goodall-Sanford, Inc. v. Tropical Co.*, 47 CCPA 823, 275 F. 2d 736, the CCPA held ROYAL PALM not confusingly similar to PALM BEACH for clothing. The Court held that PALM was only a weak word, because it appeared in ten registrations of third parties for clothing. In meaning, BEACH is dominant in one mark and TREE in the other.

The CCPA held that registrations of similar marks by third persons was evidence that the mark was a weak one and not entitled to broad protection in *Cooperative Quality Marketing, Inc. v. Dean Milk Co.*, 314 F. 2d 552, and held DAIRY CHARM registrable over COUNTRY CHARM because CHARM had been registered to a third party.

This was followed by the Board in *Conde Nast Publications, Inc. v. American Greetings Corp.*, 136 USPQ 669, where VOGUE for greeting cards was held not confusingly similar to VOGUE for a magazine, because of third party VOGUE registrations. The Board held that third party registrations were admissible in evidence to establish that a cited mark was weak and necessarily narrowed in its rights against others.

Since DEBUTANTE and other marks have been granted registration over LE DEBUT and LE DEBUT NOIR, it follows that LE DEBUT and LE DEBUT NOIR are weak

marks and narrowed in their character to their exact words. In following precedent, appellant submits that registration of its mark 2ND DEBUT should be granted.

CONCLUSION

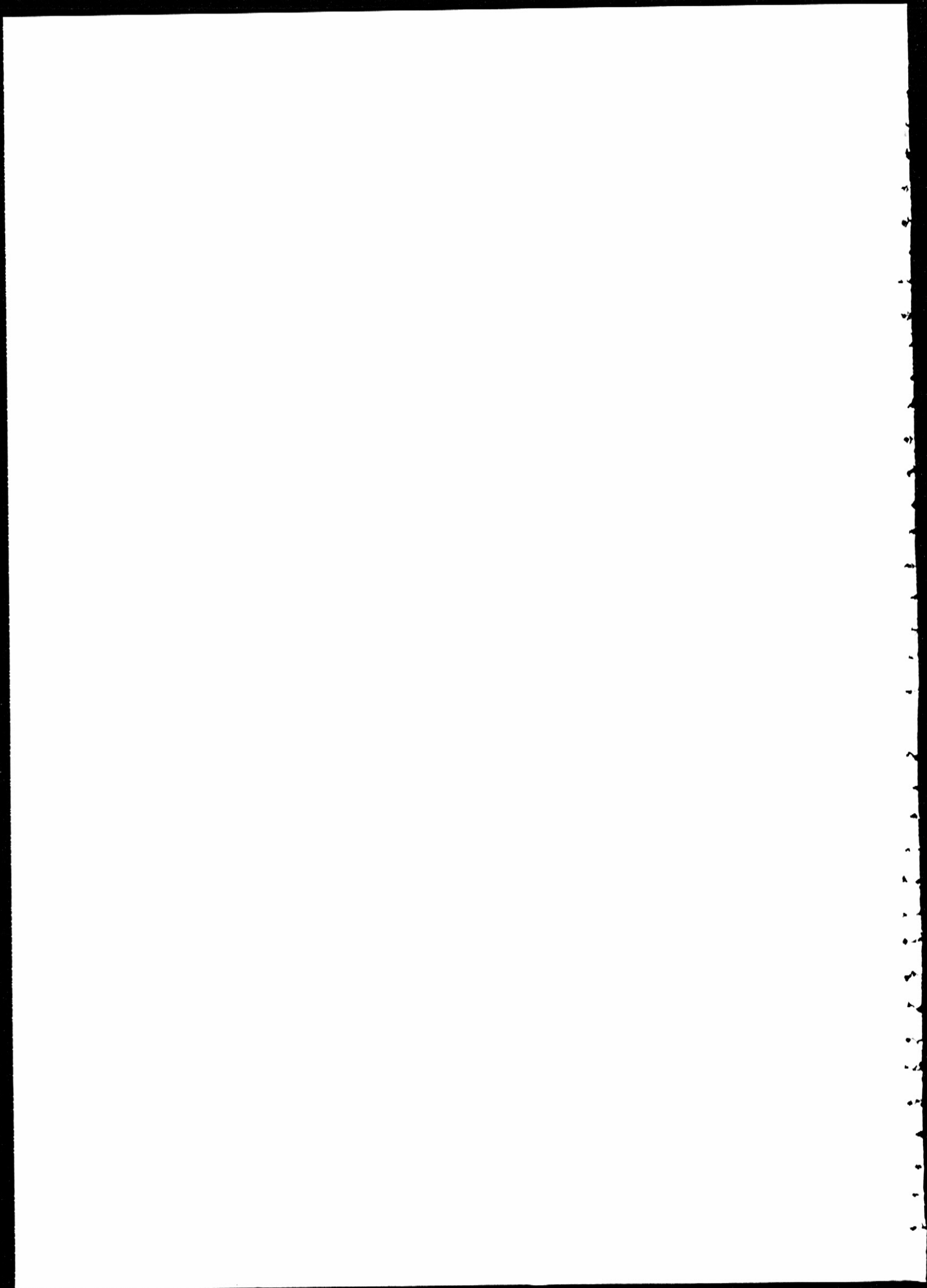
It is submitted that appellant should be granted registration of 2ND DEBUT and that the rulings below should be reversed.

Respectfully submitted,

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JOINT APPENDIX

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1202-63

ARRIVALS, LTD., 203 North Wabash Avenue,
Chicago, Illinois, *Complainant*,

v.

DAVID L. LADD, as Commissioner of Patents, Patent Office,
Washington, D. C., *Defendant*.

Complaint to Compel the Issuance of a Trademark Registration

1. This is a suit under 35 U.S.C. 145, 146 and 15 U.S.C. 1071.

2. Complainant is an Illinois corporation duly organized and existing under and by virtue of the laws of the State of Illinois, and located and doing business at 203 North Wabash Avenue, Chicago, Illinois, and is a citizen, resident and inhabitant of Chicago, Illinois; and defendant David L. Ladd is the Commissioner of Patents of the United States and resides at Washington in the District of Columbia, and is sued in his capacity as such Commissioner of Patents because without warrant of law and in violation of the complainant's legal rights, he has wrongfully refused to issue to complainant a trademark registration, as hereinafter set forth.

3. On April 27, 1960, complainant, Arrivals, Ltd., duly filed in the United States Patent Office under the Trademark Laws of the United States, an application for registration of the trademark 2ND DEBUT for aqueous moisturizing lotion, Serial No. 85,865.

4. The Examiner in the United States Patent Office rejected complainant's application for registration on the ground that it was confusingly similar to prior registra-

tions of LE DEBUT, Registration Nos. 200,218, 200,677, 420,498 and 432,820, and LE DEBUT NOIR, Registration Nos. 236,110 and 236,111 of Richard Hudnut.

5. Complainant responded to the United States Patent Office showing the differences between complaint's trademark and those of the references cited by the Examiner and also pointing out that after said references, Registrations were issued as follows: DEBUTANTE, Registration Nos. 297,827 and 506,568, MISS DEBUTANTE, Registration No. 688,456 and DEBUTETTE, Registration No. 640,485, all to Daggett & Ramsdell, Inc., DEBONAIR, Registration No. 538,612, DEBMETICS, Registration No. 441,422, DEBONY, Registration No. 521,933, and DEB-U-CURL, Registration No. 700,664.

6. Complainant's application, Serial No. 95,865, was finally rejected by the Examiner of the United States Patent Office on March 27, 1962.

7. An appeal was duly taken by complainant on said application to the Trademark Trial and Appeal Board of the United States Patent Office, which affirmed the decision of the Examiner on March 20, 1963.

8. A certified copy of the file history of said application, Serial No. 95,865 has been ordered from the Commissioner of Patents and will be filed as Exhibit A to this complaint.

9. The Examiner in the United States Patent Office and the Board erred in rejecting complainant's said application for registration of the trademark 2ND DEBUT on the grounds set forth in this complaint.

10. Complainant's trademark 2ND DEBUT is registerable in that it differs from the trademarks of the references LE DEBUT and LE DEBUT NOIR in the important first word, 2ND, which the eye catches first, the ear hears first, and the memory retains most. This first word 2ND distinguishes and characterizes complainant's trademark so as to differentiate it from the references in appearance, sound and memory.

11. Complainant's goods also differ specifically from those of the references, and furnish another ground for allowance of the mark on the doctrine of the differences in the goods taken together with the differences in the marks prevent likelihood of confusion, *Kurlash Co. v. Younghusband*, 36 USPQ 323 (CCPA).

12. Complainant's trademark is registrable because 2ND DEBUT creates such a different commercial impression from the references that there is no likelihood of confusion. The LE DEBUT references mean the first public appearance into society and LE DEBUT NOIR means that first entrance into society in black. The references relate to the young lady making her first entry into society. Complainant's trademark 2ND DEBUT refers to the older woman seeking her second chance at beauty. In use with cosmetics, it suggests the older, but still beautiful, woman who seeks a second opportunity of presenting herself well. The psychological impact of LE DEBUT is the entry into society. The commercial impression of 2ND DEBUT is the older woman beginning a second stage of beauty. The commercial impressions are so different that the concurrent use of the two trademarks would not be likely to cause confusion. There never has been any confusion in the past between complainant's 2ND DEBUT products and those of the references, and none is likely to occur in the future.

13. Complainant alleges that since DEBUTANTE, MISS DEBUTANTE, DEBUTETTE, DEBONAIR, DEBMETICS, DEBONY, and DEB-U-CUR have been granted registration over the references, LE DEBUT and LE DEBUT NOIR, that complainant's mark which differs as much from LE DEBUT and LE DEBUT NOIR as do these registrations, should also be granted registration.

14. Complainant is informed and believes and, therefore, alleges that Richard Hudnut, the owner of trademark registrations of LE DEBUT and LE DEBUT NOIR, has not used these trademarks on cosmetics or soaps for more than two years and has abandoned the same, and that said trade-

marks and registrations therefor are null and void and should be cancelled and disregarded in this case.

15. The trademark 2ND DEBUT is not shown in any or all of the references upon which the Examiner and the Trademark Trial and Appeal Board relied in denying registration in said application.

16. If said trademark registration is denied to complainant, complainant will suffer irreparable injury for which it has no adequate remedy at law and unless defendant is ordered to issue to complainant the trademark registration to which he is rightfully entitled, complainant may be powerless and remediless to protect its trademark which will result in great loss of sales and income which complainant would otherwise rightfully receive and consequent irreparable injury, loss and damage to complainant.

WHEREFORE, complainant respectfully prays this Honorable Court as follows:

1. That the writ of subpoena issue out of this Court directed to the defendant, the Commissioner of Patents, requiring him to appear in this cause and answer to this complaint.

2. That an order be issued by this Court directed to said defendant, the Commissioner of Patents, his agents, servants, subordinates or successors in office, requiring him to issue a trademark registration on application, Serial No. 95,865, to complainant.

3. That the complainant may have such other and further relief as to the Court may seem just and proper.

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105 West Adams Street
Chicago 3, Illinois

RUPERT J. BRADY
700 Tenth Street, N.W.
Washington, D. C.
Attorneys for Complainant.

Answer to Complaint

To the Honorable the Judges of the United States District Court for the District of Columbia

1. The defendant admits that this is a suit under 15 U.S.C. 1071. Otherwise, however, the defendant denies the allegations of paragraph 1 of the complaint.

2. The defendant denies that he resides at Washington in the District of Columbia. The defendant states that he is an official resident of Washington in the District of Columbia. The defendant also denies that without warrant of law and in violation of the plaintiff's legal rights, he has wrongfully refused to issue to plaintiff a trademark registration. Otherwise, the defendant admits the allegations of paragraph 2 of the complaint.

3. Except for denying that plaintiff's application for trademark registration bears Serial No. 85,865, the defendant admits the allegations of paragraph 3 of the complaint.

4. The defendant admits the allegations of paragraph 4 of the complaint.

5. The defendant denies that plaintiff showed the differences between its trademark and those of the references cited by the Examiner. Otherwise, however, the defendant admits the allegations of paragraph 5 of the complaint.

6, 7. The defendant admits the allegations of paragraphs 6 and 7 of the complaint.

8. The defendant admits that a certified copy of the file history of application, Serial No. 95,865, has been ordered from the Commissioner of Patents. The defendant asserts that, otherwise, he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 8 of the complaint.

9, 10, 11. The defendant denies the allegations of paragraphs 9, 10, and 11 of the complaint.

12. The defendant asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegation that there never has been any confusion in the past between plaintiff's 2ND DEBUT products and those of the references. Otherwise, the defendant denies the allegations of paragraph 12 of the complaint.

13. The defendant denies the allegations of paragraph 13 of the complaint.

14. The defendant asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 14 of the complaint.

15. The defendant admits the allegations of paragraph 15 of the complaint.

16. The defendant asserts that he is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 16 of the complaint.

FURTHER ANSWERING, the defendant asserts that the plaintiff is not entitled to the trademark registration, for which it made application, for the reasons given and in view of the prior registrations cited in the Examiner's statement and the decision of the Trademark Trial and Appeal Board in its application. Profert hereby is made of copies of the said statement, decision, and registrations.

Respectfully submitted,

C. W. MOORE
*Solicitor, United States
Patent Office
Attorney for Defendant*

EXCERPTS FROM TRANSCRIPT OF RECORD

[Page 12—lines 3-6]

Norman J. Phelps

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

* * * * *

[Page 12—last six lines]

Direct Examination

By Mr. McKnight:

Q. What is your name? A. Norman J. Phelps.

Q. What is your address? A. 993 Maplewood Road, Lake Forest, Illinois.

* * * * *

[Page 13]

Q. Your occupation? A. Advertising counselor.

Q. How long have you been in the advertising business?

A. Forty or forty-one years.

Q. Have you done any work in the cosmetic field?

A. Yes, I have.

Q. For how long? A. Approximately forty-one years.

Q. For whom have you done work in the cosmetic field?

A. My earliest work was for the Maybelline Company, mascara people, who are the largest of their kind. And then I came across things such as Lady Esther, Princess Pat, Dana Perfumes, Tabu, Lanolin Plus, Evyan Perfumes.

Q. What is your connection with the plaintiff, Arrivals, Limited? A. I created the advertising for it, helped in the development of the product, named it, created a name for it myself.

Q. Did you create any trademarks for Arrivals, Limited?

A. Yes, I did.

Q. What trademarks? A. Well, 2nd Debut was one.

Q. How long have you been with Arrivals, Limited?

A. Since their inception, approximately four years.

[Page 14—lines 1-15]

Q. Is Arrivals, Limited, an Illinois corporation? A. It is.

Q. What is its address? A. 203 North Wabash Avenue, Chicago.

Q. What is its business? A. Distribution and promotion of cosmetic products.

Q. Does it sell any product under the trademark "2nd Debut"? A. It does.

Q. I show you plaintiff's exhibits 2, 3 and 4 for identification and ask you if you know what they are? A. I do.

Q. What are they? A. This (indicating) is the standard package of 2nd Debut.

* * * * *

[Page 15—beginning with line 3]

Q. Under the trademark 2nd Debut? A. Under the trademark 2nd Debut; yes.

Q. What is plaintiff's exhibit 3? A. That is the 1-ounce size called the Clinical Vial of the aqueous face lotion called 2nd Debut.

Q. What is plaintiff's exhibit 4? A. Plaintiff's exhibit 4 is the liquid makeup, the standard sized package of the 2nd Debut liquid makeup.

Q. In what kind of stores are plaintiff's exhibits 2, 3 and 4 sold? A. Department stores, chain drug stores and specialty stores.

Q. Could you give us the names of any typical ones? A. Yes. Marshall Field & Company, Chicago, Fair Stores, Chicago, Bonwit Teller and their various stores, Thrifty Drug Company in Los Angeles, Hutchinson, Detroit—I am trying to think. There are so many.

Q. Is the trademark 2nd Debut well known to the trade and to the purchasing public, in your opinion? A. It is.

Q. Have you done the advertising of the trademark 2nd Debut?

[Page 16]

A. Yes, I have.

Mr. McKnight: May I ask the Clerk to mark this group plaintiff's exhibit 5?

The Deputy Clerk: Plaintiff's Exhibit 5 marked for identification.

(Plaintiff's Exhibit No. 5 was marked for identification.)

By Mr. McKnight:

Q. I show you a group of 5 papers marked for identification as plaintiff's exhibit 5 and ask you if you know what they are? A. Those are some of the newspaper advertisements used in the promotion of 2nd Debut.

Q. Do you know who wrote them? A. I did.

Q. In what kind of publications have they appeared? A. Largely in metropolitan Sunday newspapers and daily papers.

Q. Such as what? A. Oh, Chicago Tribune, Chicago Sun Times, Minneapolis Tribune, Los Angeles Times, Kansas City Star, St. Louis Post Dispatch, Dallas News; a large number of them.

Q. Has this advertising been extensive? A. Quite.

[Page 17—lines 1-15]

Q. What is the motif of this advertising? A. Well, the basic promotional idea of the motif is to suggest to the older woman through the use of this product she might recapture some of the appearance she had during her youth.

Q. Do you direct these advertisements at all to a girl making her introduction into society? A. No, we do not.

Q. In other words, the advertisements are directed solely to the older woman? A. To the older woman.

Q. Now are you familiar with cosmetic preparations on the market? A. I am.

* * * * *

[Page 18—lines 11-15]

Q. Calling your attention to defendant's exhibit 1 and to the Le Debut and Le Debut Noir registrations appearing therein, have you ever seen any advertisements for either of these products in any publications at any time? A. I have not.

* * * * *

[Page 22—beginning with line 2]

Q. I call your attention to these documents marked plaintiff's exhibit 7 for identification and ask you if that (indicating) shows the trademark "MISS DEBUTANTE" registered by Daggett & Ramsdell? A. It does.

Q. That registration was obtained after the LE DEBUT registration? A. Yes.

Q. That is also true of the other registrations of "DEBUTANTE" appearing in plaintiff's exhibit 7? A. Yes.

Q. Has Arrivals, Limited, ever received any orders for any cosmetics other than 2ND DEBUT? A. Not to my knowledge.

Q. Has Arrivals, Limited, ever received any orders for LE DEBUT cosmetics? A. No.

Q. Has it ever filled any such orders? A. No.

Q. In your opinion, do you think that there is any confusion likely to occur between your company's 2ND DEBUT product and the LE DEBUT products of Richard Hudnut?

Mr. Moore: I object, Your Honor. I don't think this

[Page 23—lines 1-14]

witness is qualified to express that conclusion as an expert witness.

The Court: Well, he is not exactly an expert, but I think he is expert enough to answer that question. You may answer.

The Witness: I have seen nothing like that occur.

By Mr. McKnight:

Q. Do you think it is likely to occur in the future, in your opinion? A. Well, others have gone through my hands in the past and I presume there will in the future.

Q. Has there been any confusion in the past that you know of? A. No, there has not been.

Opinion

This civil action was brought pursuant to 15 U.S.C. 1071 (b) seeking an adjudication by this Court that plaintiff, ARRIVALS, LTD., is entitled to register "2ND DEBUT" as a trademark for an aqueous moisturizing lotion used as a cosmetic.

Plaintiff's application, Serial No. 95,865, was filed on April 27, 1960, and asserted use of "2ND DEBUT" as a trademark on its product since April 12, 1960. The Patent Office refused registration on the basis of language in 15 U.S.C. 1052(d), which prohibits registration of a "mark which so resembles a mark registered in the Patent Office * * *, as to be likely, when applied to the goods of the applicant to cause confusion, or to cause mistake, or to deceive". The prior trademark registrations relied upon for this purpose by the Patent Office are Reg. No. 200,218, issued June 30, 1925, and renewed, Reg. No. 200,677, issued July 7, 1925, and renewed, Reg. No. 420,498, issued April 16, 1946, and Reg. No. 432,820, issued September 16, 1947, all for "LE DEBUT", and Reg. Nos. 236,110 and 236,111, both issued December 6, 1927, and both renewed, for "LE DEBUT NOIR".

Although 15 U.S.C. 1071(b) entitles the plaintiff to a trial *de novo* on the question of likelihood of confusion, mistake, or deception, controlling precedent in the District of Columbia permits the District Court to overturn the decision of the Patent Office only when the evidence "car-

ries thorough conviction" the Patent Office has erred. *Esso Standard Oil Company v. Sun Oil Company*, 97 U.S. App. D.C. 154, 229 F.2d 37, 41-42 (1956). In this same decision appears the kindred rule that "the newcomer will be refused registration should there exist any doubt as to the probability of confusion between the two trademarks".

It was undisputed at trial that the registered marks "LE DEBUT" and "LE DEBUT NOIR" are intended to be used on goods of the same character as "2ND DEBUT", and hence might be displayed side by side with them on the retailer's shelf. It was also undisputed, and is obvious from the circumstances, that the particular words selected for all the marks are arbitrary in character, and are not in any way descriptive of the properties of the goods involved.

The plaintiff's evidence consisted mainly of the argument that "2ND DEBUT" is intended to "suggest to the older woman through the use of this product she might recapture some of the appearance she had during her youth", whereas "LE DEBUT" suggests "the first introduction of a young lady into society" and "LE DEBUT NOIR" suggests "a young lady being first introduced in public dressed in black". The plaintiff also relied upon an assertion that no confusion among the three marks had occurred during the four years "2ND DEBUT" has been in use.

The Court has given this evidence considerable study but is constrained to find that it does not carry a "thorough conviction" the Patent Office has erred. There remains un rebutted, for example, the persuasive suggestion by the Solicitor that "2ND DEBUT" could easily be mistaken by a consumer for an additional but related product marketed by the manufacturer of "LE DEBUT". Additionally, the Court is compelled, under the authorities previously cited, to resolve doubts against the newcomer.

Accordingly, judgment will be entered for the defendant, and against the plaintiff, and the Complaint will be dismissed.

The above Opinion contains Findings of Fact and Conclusions of Law.

DATED: September 25, 1964.

JOSEPH R. JACKSON
United States District Judge

Order

This cause having come on for trial on March 25, 1964, and the Court having considered the record herein as well as the briefs the Court accorded the parties an opportunity to file, it is this 25th day of September, 1964,

ORDERED, that judgment be, and hereby is, entered for the defendant and against the plaintiff, and that the Complaint be, and hereby is, dismissed, and that all costs of this proceeding be assessed against the plaintiff.

JOSEPH R. JACKSON
United States District Court

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1202-63

ARRIVALS, LTD., *Plaintiff,*

v.

DAVID L. LADD, as COMMISSIONER OF PATENTS, *Defendant.*

Notice of Appeal

Notice is hereby given that plaintiff, Arrivals, Ltd., hereby appeals to the United States Court of Appeals for the District of Columbia from the Order and Judgment

entered herein on September 25, 1964, dismissing the complaint.

RUPERT J. BRADY
Rupert J. Brady
10th & G Street, N. W.
Washington, D. C.

JAMES R. McKNIGHT
James R. McKnight
105 West Adams Street
Chicago, Illinois

Attorneys for Plaintiff.

Page 1 of Plaintiff-Appellant's Exhibit No. 1
APPLICATION FOR TRADEMARK REGISTRATION
Mark 2ND DEBUT
Class No. 51

TO THE COMMISSIONER OF PATENTS:

Arrivals, Ltd., a corporation of the State of Illinois, located and doing business at 203 North Wabash Avenue, Chicago, Illinois.

The above identified applicant has adopted and is using the trademark shown in the accompanying drawing for aqueous moisturizing lotion and requests that said mark be registered in the United States Patent Office on the Principal Register established by the Act of July 5, 1946.

The trademark was first used on April 12, 1960; was first used in interstate commerce on April 12, 1960; and is now in use in such commerce.

The mark is used by applying it to labels attached to the containers of the goods and five specimens showing the mark as actually used are presented herewith.

Please recognize James R. McKnight, 105 West Adams Street, Chicago, Illinois, Registration No. 12,110, as our attorney in this application.

STATE OF ILLINOIS }
COUNTY OF COOK } ss:

Walter A. Jordan, being sworn, states that: he is Treasurer of applicant corporation and is authorized to execute this affidavit on behalf of said corporation; he believes said corporation to be the owner of the mark sought to be registered; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as might be calculated to deceive; and the facts set forth in this application are true.

ARRIVALS, LTD.

(CORPORATE SEAL)

By (signed) WALTER A. JORDAN
Treasurer

Subscribed and sworn to before me this 22nd day of April, 1960.

(signed) M. E. MURPHY
Notary Public
(NOTARY SEAL)

Page 3 of Plaintiff-Appellant's Exhibit No. 1

DRAWING

Applicant's Name—Arrivals, Ltd.,

Applicant's Post Office Address—203 North Wabash Avenue, Chicago, Illinois

Applicant's Date of First Use—April 12, 1960

Goods—Cosmetics

2ND DEBUT

Pages 25 and 26 of Plaintiff-Appellant's Exhibit No. 1
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL
Paper No. 13
Sept. 28, 1962

Applicant: Arrivals, Ltd.

Trademark: 2ND DEBUT

Serial No. 95,865, Filed Apr. 27, 1960

Attorney: James R. McKnight
105 W. Adams St.
Chicago 3, Ill.

Examiner's Statement

This is in answer to an appeal from the Examiner's refusal to register the mark 2ND DEBUT for an aqueous moisturizing lotion.

Registration has been refused in view of several registrations of LE DEBUT and LE DEBUT NOIR for cosmetics and soaps.

Applicant contends that differences in the marks and goods are sufficient to avoid confusion in trade if they are used contemporaneously. The Examiner is of the opinion that the goods of the two parties are substantially the same, namely cosmetics; and that the dominant features of the marks are identical, namely the word DEBUT.

DEBUT is the prominent feature of all the registered marks. "LE" is of little significance since it is merely the French word for "the". Many American purchasers undoubtedly would call for the goods by the name DEBUT rather than LE DEBUT. Applicant calls attention to the word "NOIR" which forms part two of the registered marks. However in both registrations the word NOIR (meaning "dark" in this context) is clearly subordinate and is used descriptively. Applicant claims that the use

of the word "2ND" in its mark makes the mark in its entirety significantly different but the Examiner cannot agree. Merely affixing a numerical designation doesn't add significantly to the mark. If that were so there could be registrations for 3RD DEBUT, 4TH DEBUT, etc. as well as for 2ND DEBUT, and all by different parties.

The goods in four of the registrations are for cosmetics including beauty lotions and creams, and the oldest of the registrations dates back to 1925. The goods in the other registrations are soap which, in context with the name of such a well-known cosmetic house as Richard Hudnut must be assumed to be toilet soaps of cosmetic quality. Thus applicant's goods, the cosmetic aqueous moisturizing lotion, are identical with, or closely related to, the goods in all the registrations.

In view of the above, contemporaneous use of the two marks would be likely to result in confusion in trade. Refusal to register in accordance with Section 2(d), in view of the reference registrations, is deemed proper.

If applicant is successful in this proceeding a corrected drawing will be required, in accordance with the Office action of October 3, 1960.

R. M. Ross

Examiner, Div. II

R.M.Ross:jee

Pages 30, 31 and 32 of Plaintiff-Appellant's Exhibit No. 1

BLH

Hearing: February 5, 1963

Paper No. 17

U. S. DEPARTMENT OF COMMERCE
TRADEMARK TRIAL AND APPEAL BOARD

IN RE APPLICATION OF
ARRIVALS, LTD.

Application for Principal Registration of a trademark
for an aqueous moisturizing lotion, Serial No. 95,865,
filed April 27, 1960.

James R. McKnight for applicant.

Before Waldstreicher, Lefkowitz, and Shryock, Members.

Opinion by Shryock, Member:

An application has been filed to register "2ND DEBUT"
for an aqueous moisturizing lotion, use since April 12,
1960 being asserted.

Registration has been refused on the ground that appli-
cant's mark so resembles the mark "LE DEBUT" for various
cosmetic preparations including cold cream, skin and tissue
cream, and vanishing cream;¹ cosmetic kits containing
various items including foundation lotion, skin freshner,
cleansing cream and skin cream;² and soap;³ and the mark
"LE DEBUT NOIR" for cosmetic preparations as set forth
above;⁴ and soap.⁵ All of the above cited registrations are
owned by Richard Hudnut.

Applicant has appealed.

¹ Reg. No. 432,820, issued Sept. 16, 1947; and Reg. No. 200,218, issued
June 30, 1925; renewed.

² Reg. No. 420,498, issued Apr. 16, 1946.

³ Reg. No. 200,677, issued July 7, 1925; renewed.

⁴ Reg. No. 236,111; issued Dec. 6, 1927; renewed.

⁵ Reg. No. 236,110, issued Dec. 6, 1927; renewed.

The goods identified in applicant's application and in the cited registrations, respectively, all fall within the category of cosmetic and/or toilet preparations and are so related in kind, that, when sold under the same or substantially similar marks, a reasonable likelihood of confusion or mistake would exist.

It is applicant's position that its mark "2ND DEBUT" creates a substantially different commercial impression from that of any of the cited marks since the latter marks all relate to a young lady making the first entry into society while its mark relates to an older woman seeking her second chance at beauty. It is extremely doubtful that the members of the purchasing public would ascribe the above mentioned significance to applicant's mark, and it is readily apparent that both applicant's mark and the marks of the cited registrations contain the word "DEBUT" as a prominent and essential feature thereof; and that such word is entirely arbitrary in nature as applied to the respective products.

While it is also contended that applicant's mark does not possess as close a resemblance to the cited marks as do certain subsequently registered marks by various other parties in the cosmetic field, the propriety of the issuance of such registrations is not the issue here. The only question before the Board is whether or not registration of "2ND DEBUT" is precluded under the provisions of Section 2(d) of the Statute in view of the cited registration.

In view of the nature and prominence of the word "DEBUT" in each of the registered marks it is concluded that applicant's "2ND DEBUT" so resembles each of the registered marks as to be likely, when applied to applicant's goods, to cause confusion, or to cause mistake, or to deceive.

Decision:

The refusal to register is affirmed.

R. F. SHRYOCK

H. WALDSTREICHER

S. LEFKOWITZ

*Member, Trademark Trial
and Appeal Board*

Mar. 20, 1963

Registered June 30, 1925.

Trade-Mark 200,218

RENEWED

JUN 30 1945

UNITED STATES PATENT OFFICE.**RICHARD HUDNUT, OF NEW YORK, N. Y.****ACT OF FEBRUARY 20, 1905.**

Application filed February 6, 1925. Serial No. 209,165.

LE DEBUT**STATEMENT.***To the Commissioner of Patents:*

Richard Hudnut, a corporation duly organized under the laws of the State of New York, and located and doing business at No. 113 West 18th Street, in the borough of Manhattan, city, county, and State of New York, has adopted and used the trade-mark shown in the accompanying drawing, for FACE POWDERS, TALCS, BATH SALTS, SACHETS, TOOTH POWDERS, ALMOND MEAL, TOILET WATERS, HEADACHE COLOGNES, SMELLING SALTS, VANISHING CREAMS, COLD CREAMS, TOOTH PASTES, PERFUMES, LIP ROUGE, BATH POWDERS, TOILET CERATE, SKIN AND TISSUE CREAMS, in Class 6, Chemicals, medicines, and pharmaceutical preparations, and presents herewith five (5) specimens showing the trade-mark as actually used by the applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20,

1905, as amended. The trade-mark has been continuously used and applied to said goods in the business of applicant since January 22, 1925. The trade-mark is applied or affixed to the goods or to the packages containing the same by placing thereon a printed or lithographed label on which the trade-mark is shown.

The undersigned hereby appoints Baldwin, Hutchins & Todd, composed of Rogers S. Baldwin, Hiram C. Todd, Robert A. Young and Danforth Geer, Jr., Esqs., whose postal address is No. 120 Broadway, borough of Manhattan, city, county and State of New York, its attorneys to prosecute this application for registration with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

[L. s.]

RICHARD HUDNUT,
By **ERNEST B. BENSON,**
Secretary.

Registered July 7, 1925.

Trade-Mark 200,677

RENEWED

JUL 7 1945

UNITED STATES PATENT OFFICE.

RICHARD HUDNUT, OF NEW YORK, N. Y.

ACT OF FEBRUARY 20, 1905.

Application filed February 12, 1925. Serial No. 209,478.

LE DEBUT

STATEMENT.

To the Commissioner of Patents:

Richard Hudnut, a corporation duly organized under the laws of the State of New York, and located and doing business at No. 113 West 18th Street, in the borough of Manhattan, city, county, and State of New York, has adopted and used the trade-mark shown in the accompanying drawing, for SOAP, in Class 4. Abrasive, detergent, and polishing materials, and presents herewith five (5) specimens showing the trade-mark as actually used by the applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905, as amended. The trade-mark has been continuously used and applied to said goods in the business of applicant since January 22, 1925. The trade-mark is applied or affixed to the goods or

to the packages containing the same by placing thereon a printed or lithographed label on which the trade-mark is shown.

The undersigned hereby appoints Baldwin, Hutchins & Todd, composed of Roger S. Baldwin, Hiram C. Todd, Robert A. Young and Danforth Geer, Jr., Esqs., whose postal address is No. 120 Broadway, borough of Manhattan, city, county, and State of New York, its attorneys to prosecute this application for registration with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

[L. S.]

RICHARD HUDNUT,
By ERNEST B. BENSON,
Secretary.

Registered Dec. 6, 1927.

Trade-Mark 236,110

Renewed Dec. 6, 1947, to Richard Hudnut,
New York, N. Y.

UNITED STATES PATENT OFFICE.

RICHARD HUDNUT, OF NEW YORK, N. Y.

ACT OF FEBRUARY 20, 1905.

Application filed August 3, 1927. Serial No. 252,964.

LE DEBUT NOIR

STATEMENT.

To the Commissioner of Patents:

Richard Hudnut, a corporation duly organized and existing under and by virtue of the laws of the State of New York, and located and doing business at No. 113 West 18th Street, in the borough of Manhattan, New York, N. Y., has adopted and used the trade-mark shown in the accompanying drawing, for SOAP, in Class 4, Abrasive, detergent, and polishing materials, and presents herewith five specimens showing the trade-mark as actually used by the applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905, as amended. The trade-mark has been continuously used and applied to said goods in applicant's business since July 25, 1927. The trade-mark is applied or affixed to the goods or to the packages containing the same by placing thereon a printed or lithographed label on which the trade-mark is shown. No registration rights are

claimed for the word "Noir" apart from the mark shown in the drawing, but applicant waives none of its common-law rights to said mark of any element thereof.

Applicant is the owner of trade-mark registration No. 200,677 registered on July 7, 1925.

The undersigned hereby appoints Baldwin, Hutchins & Todd, composed of Roger S. Baldwin, Hiram C. Todd, Robert A. Young, Danforth Geer, Jr., and Gillet Lefferts, Esqs., whose postal address is No. 120 Broadway, borough of Manhattan, city of New York, State of New York, its attorneys, to prosecute this application for registration, with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate, and to transact all business in the Patent Office connected therewith.

[L. S.]

RICHARD HUDNUT,
By GUSTAVUS A. PFEIFFER,
President.

RENEWED

Registered Dec. 6, 1927.

Trade-Mark 236,111

Renewed Dec. 6, 1947, to Richard Hudnut,
New York, N. Y.**UNITED STATES PATENT OFFICE.****RICHARD HUDNUT, OF NEW YORK, N. Y.****ACT OF FEBRUARY 20, 1905.**

Application filed August 3, 1927. Serial No. 252,963.

**LE DEBUT
NOIR****STATEMENT.***To the Commissioner of Patents:*

Richard Hudnut, a corporation duly organized and existing under and by virtue of the laws of the State of New York, and located and doing business at No. 113 West 18th Street, in the borough of Manhattan, New York, N. Y., has adopted and used the trade-mark shown in the accompanying drawing, for COLD CREAM, BATH SALTS, PERFUME, ALMOND MEAL, TOILET CERATE, HEADACHE COLOGNE, FACE POWDER, BATH POWDER, TALCUM POWDER, TOOTH POWDER, TOOTH PASTE, TOILET WATER, SMELLING SALTS, SKIN AND TISSUE CREAM, LIP ROUGE, SACHET, AND VANISHING CREAM, in Class 6, Chemicals, medicines, and pharmaceutical preparations, and presents herewith five specimens showing the trade-mark as actually used by the applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905, as amended. The trade-mark has been continuously used and applied to said goods in applicant's business since July 25, 1927. The trade-mark is applied or affixed to the

goods or to the packages containing the same by placing thereon a printed or lithographed label on which the trade-mark is shown. No registration rights are claimed for the word "Noir" apart from the mark shown in the drawing, but applicant waives none of its common-law rights to said mark or any element thereof.

Applicant is the owner of trade-mark registration No. 200,218 registered on June 30, 1925.

The undersigned hereby appoints Baldwin, Hutchins & Todd, composed of Roger S. Baldwin, Hiram C. Todd, Robert A. Young, Danforth Geer, Jr., and Gillet Leferts, Esqs., whose postal address is No. 120 Broadway, borough of Manhattan, city of New York, State of New York, its attorneys, to prosecute this application for registration, with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate, and to transact all business in the Patent Office connected therewith.

[L. s.] RICHARD HUDNUT,
By GUSTAVUS A. PFEIFFER,
President.

Registered Apr. 16, 1946

Trade-Mark 420,498

UNITED STATES PATENT OFFICE

Richard Hudnut, New York, N. Y.

Act of February 20, 1905

Application July 6, 1945, Serial No. 485,499

LE DEBUT**STATEMENT***To the Commissioner of Patents:*

Richard Hudnut, a corporation duly organized and existing under and by virtue of the laws of the State of New York, having an office at 113 West 18th Street, New York, New York, has adopted and used the trade-mark shown on the accompanying drawing, for COSMETIC KITS CONTAINING THE FOLLOWING: FOUNDATION LOTION, SKIN FRESHENER, CREAM ROUGE, EYEBROW PENCIL, EYE SHADOW, SKIN CREAM, CLEANSING CREAM, FACE POWDER, LIPSTICK, COMB, MIRROR, COIN PURSE AND CLEANSING TISSUES, in Class 50, Merchandise not otherwise classified, and presents herewith five specimens showing the trade-mark as actually used upon the goods and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905.

The trade-mark has been continuously used and applied to said goods in applicant's business since May 29, 1945. The trade-mark is applied and affixed to the goods by direct impression, abrasion or addition thereon, or on the packages containing the same, or by attaching a label on which the trade-mark is shown to the goods or to the packages containing the same.

The undersigned hereby appoints John M. Leach, whose postal address is 113 West 18th Street, New York, New York, its attorney, to prosecute this application for registration, with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

RICHARD HUDNUT,
By T. P. HASTINGS,
Secretary.

Registered Sept. 16, 1947

Trade-Mark 432,820

UNITED STATES PATENT OFFICE

Richard Hudnut, New York, N. Y.

Act of February 20, 1905

Application December 20, 1945, Serial No. 493,598

LE DEBUT

STATEMENT

To the Commissioner of Patents:

Richard Hudnut, a corporation duly organized and existing under and by virtue of the laws of the State of New York, having an office at 113 West 18th Street, Borough of Manhattan, city, county, and State of New York, has adopted and used the trade-mark shown on the accompanying drawing, for CLEANSING CREAMS, SACHET POWDER, LEG MAKEUP, MASCARA, EYE SHADOW, CREAM AND CAKE ROUGE, ASTRINGENT, SKIN FRESHENER, DEODORANT, POWDER LOTION, SKIN FIRMING LOTION, ANTISEPTIC LOTION, FOUNDATION LOTION, CAKE MAKEUP, EYEBROW PENCIL AND MAKEUP BASE, in Class 6, Chemicals, medicines, and pharmaceutical preparations, and presents herewith five specimens showing the trade-mark as actually used upon the goods and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905.

The trade-mark has been continuously used and applied in applicant's business to cleansing cream, sachet powder, leg makeup, mascara, eye

shadow, cream and cake rouge, astringent, skin freshener, deodorant, powder lotion, skin firming lotion, antiseptic lotion, foundation lotion and cake makeup, since May 29, 1945; to makeup base, since September 21, 1945; and to eye-brown pencil, since November 16, 1945. The trade-mark is applied and affixed to the goods by direct impression, abrasion or addition thereon, or on the packages containing the same, or by attaching a label on which the trade-mark is shown to the goods or to the packages containing the same.

Applicant is the owner of the following trade-mark registrations: No. 200,218, "Le Debut," registered June 30, 1925; No. 241,527, "Le Debut Blanc," registered May 1, 1928; No. 241,334, "Le Debut Bleu," registered April 24, 1928; No. 236,111, "Le Debut Noir," registered December 6, 1927; No. 241,333, "Le Debut Vert," registered April 24, 1928.

RICHARD HUDNUT,
By T. P. HASTINGS,
Secretary.

United States Patent Office

640,485

Registered Jan. 22, 1957

PRINCIPAL REGISTER Trademark

Ser. No. 6,233, filed Apr. 12, 1956

DEBUTETTE

Daggett & Ramsdell, Inc. (Delaware corporation)
350 5th Ave.
New York 1, N. Y.

For: TOILET WATER, in CLASS 51.
First use Feb. 13, 1956; in commerce Feb. 13, 1956.
Owner of Reg. Nos. 297,827 and 506,568.

Registered Feb. 8, 1949

Registration No. 506,568

PRINCIPAL REGISTER
Trade-Mark

UNITED STATES PATENT OFFICE

Daggett & Ramsdell, New York, N. Y., assignor to
Daggett & Ramsdell, Inc., New York, N. Y., a
corporation of Delaware

Act of 1946

Application February 4, 1948, Serial No. 548,719

Débutante

(Statement)

Daggett & Ramsdell, a corporation duly organized under the laws of the State of New York, domiciled at New York, New York, and doing business at 216 West 14th Street, city, county, and State of New York, has adopted and used the trade-mark shown in the accompanying drawing, for FACE POWDER; PREPARATIONS FOR TREATING THE SKIN; TOILET, CLEANSING, VANISHING, AND COLD CREAMS; BEAUTY LOTION; SKIN FRESHENER, DEODORANT COLOGNE; ROUGE AND LIPSTICK, in Class 6, Chemicals, medicines, and pharmaceutical preparations, and presents herewith five specimens showing the trade-mark as actually used by applicant in connection with such goods, the trade-mark being applied to the goods by attaching to the container a printed tag or label on which the trade-mark is shown, or by printing it directly on the containers, and requests that the same be registered in the United States Patent Office on the Principal Register in accordance with the act of July 5, 1946.

The trade-mark was first used in January 1913, and first used in commerce among the several

States which may lawfully be regulated by Congress in January 1913.

Applicant is the owner of registration No. 297,827, of October 4, 1932.

(Declaration)

W. Bonyun, being duly sworn, deposes and says that he is the president of Daggett & Ramsdell, the applicant named in the foregoing statement, that he believes that said corporation is the owner of the trade-mark which is in use in commerce among the several States and that no other person, firm, corporation or association, to the best of his knowledge and belief, has the right to use such trade-mark in commerce, which may lawfully be regulated by Congress either in the identical form thereof or in such near resemblance thereto as might be calculated to deceive, that the drawing and description truly represent the trade-mark sought to be registered, that the specimens show the trade-mark as actually used in connection with the goods, and that the facts set forth in the statement are true.

DAGGETT & RAMSDELL,
By W. BONYUN,
President.

Registered Oct. 4, 1932

Trade-Mark 297,827

Renewed Oct. 4, 1952, to Daggett & Ramsdell, Inc.,
Newark, N. J., a corporation of Delaware.

UNITED STATES PATENT OFFICE

DAGGETT & RAMSDELL, OF NEW YORK, N. Y.

ACT OF FEBRUARY 20, 1905

Application filed June 4, 1932. Serial No. 327,729.

DEBUTANTE

STATEMENT

To the Commissioner of Patents:

Daggett & Ramsdell, a corporation duly organized under the laws of the State of New York, and located at New York, New York, and doing business at No. 2 Park Avenue, city, county, and State of New York, has adopted and used the trade-mark shown in the accompanying drawing, for **FACE POWDER, PREPARATIONS FOR TREATING THE SKIN, AND TOILET, CLEANSING, VANISHING, AND COLD CREAMS**, in Class 6, Chemicals, medicines, and pharmaceutical preparations, and presents herewith five specimens showing the trade-mark as actually used by applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905. The trade-mark has been continuously used and applied to said goods in applicant's business since January, 1913.

Applicant is the owner of registration No. 102,963, of March 9, 1915.

The trade-mark is applied to the goods by means of printed labels attached to the containers and also by printing it directly on the containers.

Applicant hereby appoints Browne & Phelps, Suite 850 Munsey Building, Washington, D. C., a firm composed of Francis L. Browne, Dudley Browne, Nelson J. Jewett and Thomas L. Mead, jr., its attorneys, to prosecute this application for registration with full power of substitution and revocation, to make alterations and amendments therein, to receive the certificate, and to transact all business in the Patent Office connected therewith.

[L. S.]

DAGGETT & RAMSDELL,
By **F. W. MOSS,**
Vice President.

45
BRIEF FOR APPELLEE

IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 19,091

ARRIVALS, LTD., APPELLANT

v.

DAVID L. LADD, COMMISSIONER OF PATENTS, APPELLEE

Appeal from the Judgment of the United States
District Court for the District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

FILED MAR 12 1965

Nathan J. Paulson
CLERK

CLARENCE W. MOORE, OK
Solicitor, United States Patent Office
Attorney for Appellee.

APPEAL NO. 19,091

STATEMENT OF QUESTION PRESENTED

In the opinion of appellee, the single question is:

Did the District Court commit reversible error in finding, with the two tribunals of the Patent Office, on the issue presented to them and to it, that, as applied to cosmetic preparations, appellant's mark, 2ND DEBUT, and the registered trademarks, LE DEBUT and LE DEBUT NOIR, are confusingly similar.

III

INDEX

	Page
Statement of Question Presented	I
Jurisdictional Statement	1
Counterstatement of The Case	3
Statute Involved	5
Summary of Argument.....	6
Argument	6
The Burdens on Appellant	6
Appellant's Evidence	7
Prior Decisions In Other Cases.....	9
"Third Party" Registrations.....	13
Conclusion	15
Cases Cited:	
*Esso Standard Oil Company v. Sun Oil Company, 97 U.S. App. D.C. 154; 229 F.2d 37	7, 14
Helene Curtis Industries, Inc., In re, 49 CCPA 1367, 305 F.2d 492	15
Lanolin Plus Cosmetics, Inc. v. Marzall et al., 90 U.S. App. D.C. 349, 196 F.2d 591, cert. den., 344 U.S. 823	14
*McKinnon & Co. v. Hy Vis Oils, Inc., 88 F.2d 699, 24 CCPA 1105	8
Shoe Corp. of America v. The Juvenile Shoe Corp. of America, 46 CCPA 868, 266 F.2d 793	14
Sun Oil Company v. Watson et al., 122 F. Supp. 629	13
The Pepsodent Co. v. Comfort Manufacturing Co., 23 CCPA 1224, 83 F.2d 906	15
Westgate-Sun Harbor Co. v. Watson, 92 U.S. App. D.C. 341, 206 F.2d 458	9

* Cases chiefly relied upon are marked by asterisks.

IV

Statutes Cited:	Page
Section 2(d) of the Trademark Act of 1946 (Public Law 489, 79th Congress, Chapter 540, approved July 5, 1946; 60 Stat. 427), as amended (Public Law 772, 87th Congress, approved October 9, 1962, 76 Stat. 769), 15 U.S.C. 1052(d)	3, 5
Section 21 of the Trademark Act of 1946, as amended, section 21(b)(1), 15 U.S.C. 1071 (b)(1)	2
Title 28, U.S.C., section 1291 (June 25, 1948, c. 646, § 1, 62 Stat. 869. As amended October 31, 1951, c. 655, § 48, 65 Stat. 726; July 7, 1958, Pub. L. 85-508, § 12(e), 72 Stat. 348)	3

IN THE
United States Court of Appeals
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ARRIVALS, LTD., APPELLANT

v.

DAVID L. LADD, COMMISSIONER OF PATENTS, APPELLEE

Appeal from the Judgment of the United States
District Court for the District of Columbia

BRIEF FOR THE COMMISSIONER OF PATENTS

JURISDICTIONAL STATEMENT

The civil action under review, in which appellant sought, unsuccessfully, to have the United States District Court for the District of Columbia authorize the issuance to it of the trademark registration for which it made application (J.A. 14 and 15) in the Patent Office on April 27, 1960, under Serial No.

95,865 (J.A. 11, second paragraph of Opinion), was commenced on May 10, 1963, by the filing of the complaint (J.A. 1). As commenced as of such date, it is a civil action under 15 U.S.C. 1071, as amended, and particularly under 15 U.S.C. 1071(b). The entire section, section 21 of the Trademark Act of 1946, was rewritten by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769. Rewritten subsection (b) (1) reads as follows:

(b) (1) Whenever a person authorized by section 21(a) hereof to appeal to the United States Court of Customs and Patent Appeals is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said Court of Customs and Patent Appeals, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 21(a). The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Commissioner to take any necessary action, upon compliance with the requirements of law.

The person authorized by section 21(a) to appeal to the United States Court of Customs and Patent Appeals may be an "applicant for registration of a mark."

By virtue of appeal duly taken, this Court has jurisdiction under title 28, U.S.C. section 1291 (June 25, 1948, c. 646, § 1, 62 Stat. 869. As amended October 31, 1951, c. 655, § 48, 65 Stat. 726; July 7, 1958, Pub. L. 85-508, § 12(e), 72 Stat. 348).

COUNTERSTATEMENT OF THE CASE

In its application (J.A. 14 and 15), Serial No. 95,865, filed April 27, 1960, and asserting use since April 12, 1960, appellant applied for registration, on the Principal Register, of "2ND DEBUT" for goods described as "aqueous moisturizing lotion." Registration of said mark for such goods was refused by the examiner of trademarks, whose refusal was affirmed by the Trademark Trial and Appeal Board and sustained by the District Court. Their basis of refusal, grounded on section 2(d) of the Trademark Act, as amended, 15 U.S.C. 1052(d), is that appellant's mark, as applied to appellant's goods, so resembles two marks, "LE DEBUT" and "LE DEBUT NOIR", previously registered in the Patent Office to Richard Hudnut, as to be likely to cause confusion, or to cause mistake, or to deceive. On this matter, the Trademark Trial and Appeal Board specifically stated (J.A. 19, final paragraph) :

In view of the nature and prominence of the word "DEBUT" in each of the registered marks it is concluded that applicant's "2ND DEBUT" so resembles each of the registered marks as to be likely, when applied to applicant's goods, to cause confusion, or to cause mistake, or to deceive.

Richard Hudnut has registered "LE DEBUT" for various cosmetic preparations in the field of beauty lotions and creams including cold creams, skin and tissue creams, and vanishing creams (Reg. No. 432,820, issued September 16, 1947 and Reg. No. 200,218, issued June 30, 1925, renewed; J.A. 26 and 21); for cosmetic kits containing various items including foundation lotion, skin freshener, cleansing cream, and skin cream (Reg. No. 420,498, issued April 16, 1946; J.A. 25); and for soap (Reg. No. 200,677, issued July 7, 1925, renewed; J.A. 22). Richard Hudnut has registered "LE DEBUT NOIR" for similar cosmetic preparations (Reg. No. 236,111, issued December 6, 1927, renewed; J.A. 24) and for soap (Reg. No. 236,110, issued December 6, 1927, renewed; J.A. 23).

"The goods identified in applicant's [appellant's] application and in the cited registrations," the Trademark Trial and Appeal Board ruled (J.A. 19, first paragraph), "all fall within the category of cosmetic and/or toilet preparations and are so related in kind, that, when sold under the same or substantially similar marks, a reasonable likelihood of confusion or mistake would exist." With respect to the same matter, the District Court stated (J.A. 12):

It was undisputed at trial that the registered marks "LE DEBUT" and "LE DEBUT NOIR" are intended to be used on goods of the same character as "2ND DEBUT", and hence might be displayed side by side with them on the retailer's shelf. It was also undisputed, and is obvious from the circumstances, that the particular words

selected for all the marks are arbitrary in character, and are not in any way descriptive of the properties of the goods involved.

Four registrations mentioned in the second paragraph of appellant's "Statement of the Case" (Brief, page 2) are neither referred to in the "Statement of Points on which Appellant Intends to Rely on this Appeal" (*ibid.*, page 3; see paragraph 4) nor included in the Joint Appendix.

STATUTE INVOLVED

Involved is subsection (d) of section 2 of the Trademark Act of 1946 (Public Law 489, 79th Congress, Chapter 540, approved July 5, 1946; 60 Stat. 427), as amended (Public Law 772, 87th Congress, approved October 9, 1962, 76 Stat. 769), 15 U.S.C. 1052(d). It provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
* * *

(d) consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive * * *

SUMMARY OF ARGUMENT

1. Appellant must sustain, but has not sustained, the burden of overcoming, by evidence carrying thorough conviction, the finding of fact in the Patent Office that appellant's mark, 2ND DEBUT, is confusingly similar to the registered marks LE DEBUT and LE DEBUT NOIR; the burden of establishing the inapplicability of the settled rule that "the newcomer will be refused registration should there exist any doubt as to the probability of confusion between the * * * marks"; and the burden of showing clear error in that finding as accepted by the District Court.

2. Appellant's evidence does not carry the required thorough conviction. Purchasers would not be apt to ascribe appellant's special significance to its mark. It and the registered marks are, moreover, much alike in appearance and sound. Appellant's product might well be considered as part of the line of registrant's cosmetic preparations.

3. Prior trademark decisions in other cases, cited by appellant, are of dubious value as precedents. They were decided on their own peculiar facts.

4. In this Court, "third party" registrations are entitled to no weight.

ARGUMENT

The Burdens on Appellant

To prevail on this appeal, appellant must sustain, but has not sustained, three heavy burdens, to two of which the District Court referred (J.A. 11, final paragraph). As this Court will note, the finding, of fact,

by the two tribunals of the Patent Office of confusing similarity between appellant's mark and the registrant's marks "must be accepted as controlling, unless the contrary is established by evidence 'which, in character and amount carries thorough conviction'", or unless, alternatively, "the decision of the Patent Office is not warranted on the evidence before it." *Esso Standard Oil Company v. Sun Oil Company*, 97 U.S. App. D.C. 154, 157, 159; 229 F.2d 37, 40, 42. As this Court will further note, reference is made in the cited decision, antepenultimate paragraph, to another injunction upon it and the trial court, and consequent burden upon appellant, expressed, as follows:

In suits of the instant sort the courts should not lightly overturn the ruling of the Patent Office when its findings, as here, are in accord with the settled rule that "the newcomer will be refused registration should there exist any doubt as to the probability of confusion between the two marks. In other words, any doubt will be resolved against the newcomer."

Finally, as this Court will note from Rule 52 of the Federal Rules of Civil Procedure, the finding of fact as to confusing similarity made by the District Court (J.A. 12, final paragraph) is not to be set aside "unless clearly erroneous".

Appellant's Evidence

This is a case, it is submitted, "(w)here the decision of the Patent Office has a substantial basis in fact, and where the new evidence offered to the trial

court is not sufficient to shift the balance (i.e., is not enough to produce 'thorough conviction' to the contrary)."

Prominent place is given by appellant to the advertisements which it introduced at the trial as Plaintiff's Exhibit No. 5. The basic motif of these advertisements may be to suggest "to the older woman" that through the use of the advertised product "she might recapture some of the appearance she had during her youth," as appellant's sole witness, Norman J. Phelps, indicated (J.A. 9). The question, however, is not whether this "motif creates a new and distinct commercial impression and psychological impact" (see Appellant's Brief, page 5, final paragraph), but whether, as appellant urged, unsuccessfully, before the Trademark Trial and Appeal Board (see J.A. 19, second paragraph), its mark, 2ND DEBUT, relates to an older woman seeking her second chance at beauty. The Board held it extremely doubtful that the members of the purchasing public, which, of course, would include next year's purchasers, would ascribe that significance to appellant's mark. Confusing similarity, moreover, is not to be determined merely from meaning, which, it is assumed, is what appellant alludes to in his references to "commercial impression" and "psychological impact". As noted in *McKinnon & Co. v. Hy Vis Oils, Inc.*, 88 F.2d 699, 24 CCPA 1105, cited in the *Esso* case, three considerations are relevant on the issue of whether marks have a confusing similarity—appearance, meaning, and sound. Incorporating, as a prominent and essential

feature (see J.A. 19, second paragraph), the term "DEBUT", the three marks before this Court are much alike in appearance and sound. The ordinary purchaser, furthermore, would be prone to believe that a cosmetic preparation sold under the mark "2ND DEBUT" is another product in registrant's line of "LE DEBUT" and "LE DEBUT NOIR" cosmetic preparations, or is sponsored in some way by the registrant. The District Court noted (J.A. 12, final paragraph) that appellant had not rebutted this "persuasive suggestion * * * that '2ND DEBUT' could easily be mistaken by a consumer for an additional but related product marketed by the manufacturer of 'LE DEBUT'".

Appellant insists (Brief, page 6, third paragraph), on the basis of further testimony of Mr. Phelps (J.A. 10 and 11), that there has been no confusion in trade. But the absence of actual confusion, even over long periods of time, has "very little probative force," and "is not a controlling factor." *Westgate-Sun Harbor Co. v. Watson*, 92 U.S. App. D.C. 341, 345, 206 F.2d 458, 462, and cases cited.

Prior Decisions in Other Cases

Appellant says (Brief, page 8, second paragraph) that it "has found that there are many authorities sustaining the position that where the commercial impressions are different, * * * the mark is allowable over the reference;" several decided trademark cases are cited (Brief, page 9, second and third paragraphs; page 10, first and second paragraphs). There is, of course, no rule of law to such effect. The cited cases were decided on their own peculiar facts, which are

not the facts of the case at bar, and they hence, like all trademark cases not adjudicating a question of law, are of dubious value as precedents.

Somewhat the same observations apply to these cases and other cases as cited by appellant in support of the alleged proposition that a new trademark may contain in its entirety an old trademark if the new trademark presents such a different meaning that there is no likelihood of confusion (Brief, page 8, third paragraph, through page 9, first paragraph). The case of *Intercontinental Mfg. Co., Inc. v. Continental Motors Corp.*, 43 CCPA 841, 230 F.2d 621, is representative. The rationale of the decision in the specified case is manifold. For one thing, stress was laid upon the fact that the competing marks, "INTER-CONTINENTAL" and "CONTINENTAL", are primarily geographical in significance. The Court said:

Appellee points out that its entire mark "Continental" is included in appellant's mark "Intercontinental," and argues that confusion is likely to result "when the subsequent user appropriates a registered mark in its entirety and adds an insignificant syllable thereto."

Clearly the marks involved are not coined or artificial words, but are words in common use. Both are primarily geographical in their significance but their geographical meanings are sharply distinguished, one referring to a single continent and the other to two or more continents. As applied to merchandise, we think they tend to suggest the scope of the actual or expected market. In that connection it is noted that the testimony shows that appellant's goods are sold prin-

cipally in Turkey, South Africa, Mexico, Argentina, Brazil, and other foreign countries.

Normally, the degree of similarity which is permissible between trademarks consisting of ordinary words, especially when such words are descriptive or geographical, is greater than that permissible between arbitrary or fanciful marks.

In this connection, it is to be noted that, in the application at bar, the Trademark Trial and Appeal Board expressly found (J.A. 19, second paragraph) that, as applied to the respective products of appellant and the registrant, "DEBUT" is "entirely arbitrary in nature." Along the same line, the District Court (J.A. 12, first paragraph, second sentence) had the following to say:

It was also undisputed, and is obvious from the circumstances, that the particular words selected for all the marks are arbitrary in character, and are not in any way descriptive of the properties of the goods involved.

The Court of Customs and Patent Appeals, in the cited case, also stressed differences in "meaning, sound, and appearance" between the competing marks. It stated:

In our opinion the instant mark "Intercontinental" would not be regarded merely as appellee's mark "Continental" with two syllables added, but as a new word having such a different meaning, sound, and appearance as to preclude the likelihood of confusion. We think that particularly true in view of the nature, use, and relative cost of the respective goods, all of which suggest the exercise of care and discrimination on the part of purchasers thereof.

Finally, that Court noted that "likelihood of confusion is largely a matter of opinion, to be determined on the merits of each individual case."

The bases of the decision in *Ford Motor Co. v. Partridge, Singer & Baldwin, Inc.*, 58 App. D.C. 195, 26 F.2d 567, a case cited by appellant from this Circuit, are much like those in the specified case before the Court of Customs and Patent Appeals. Appellant, there, petitioned for cancellation, alleging, *inter alia*, confusing similarity between its mark "FORD" and appellee's (registrant's) mark "WARFORD". In its decision, the Court of Appeals said:

Cancellation is sought first on the ground that the registered mark has for "its principal characteristic and predominating feature the word 'Ford,' which is the principal characteristic and predominating feature of the Ford Motor Company's corporate name"; and, second, that the registered mark "is so similar to the trade-mark of the Ford Motor Company as to be likely to cause confusion in the minds of the public, and is calculated to deceive and mislead the public into the belief that the goods of the said Partridge, Singer & Baldwin, Inc., are produced and sold by the Ford Motor Company."

We agree with the decision of the Commissioner that the last syllable in registrant's mark is a word in common use, and is the same as the ending of many surnames, and is not such an appropriation of appellant's corporate name as to justify legal intervention, and that the appearance and pronunciation of the word "Warford" is so distinctively different from the word

"Ford" standing alone as to obviate any probability of confusion either as to origin or reputation.

For the same reason the second ground advanced in support of the petition for cancellation was properly denied by the tribunals below. The testimony discloses the use of registrant's mark since January, 1922, and the goods manufactured are intended for use and sold by dealers for use on Ford automobiles, and, though appellee company in the meantime has built up a business of approximately \$7,000,000, no evidence was submitted of actual confusion of either goods or origin. Neither are we of opinion that the marks are so similar as to probably lead to confusion.

"Third Party" Registrations

Appellant offered in evidence as Plaintiff's Exhibit No. 7 eight trademark registrations of others issued by the Patent Office after, it says (albeit not with entire accuracy), the reference registrations of Richard Hudnut for "LE DEBUT" and "LE DEBUT NOIR". These eight registrations, appellant asserts (Brief, page 11), so limit the references that they should not be cited to prevent appellant's registration of 2ND DEBUT. The position of appellant seems to be (see Brief, paragraph bridging pages 11 and 12) that the registrations show either (1) lack of consistency in adjudication in the Patent Office, or (2) weakness in the trademarks of the reference registrations.

In *Sun Oil Company v. Watson et al.*, 122 F. Supp. 629, District Judge Letts received certain "third party" registrations in evidence for the limited pur-

pose of showing that in the marks, "SUNVIS" and "UNIVIS", the dominant parts, respectively, are "SUN" and "UNI". He referred to the fact that defendant Esso Standard Oil Company had "objected to the introduction of the 'third party' registrations, * * * under the doctrine that prior trademark registrations may not be considered for the purpose of giving a limited application to an opposer's mark and that such third party registrations may not be considered in determining the question of confusing similarity between the mark of an applicant and that of an opposer." He ruled that no weight would be given to the "third party" registrations "in violation of the principles of law mentioned in the objection." This Court found no error in the admission of said registrations for said limited purpose. *Esso Standard Oil Company v. Sun Oil Company*, *supra*, footnote 6. In *Lanolin Plus Cosmetics, Inc. v. Marzall et al.*, 90 U.S. App. D.C. 349, 196 F.2d 591, cert. den., 344 U.S. 823, this Court would appear to have given no weight to "third party" registrations. In affirming the holding of the Patent Office and the District Court that "LANOLIN PLUS", as applied to soap and cosmetics, is "descriptive", this Court said:

Appellant appears to be right in its contention that a number of similar trade marks which the Patent Office has registered are equally descriptive. But the fact that the Office has erred in those instances does not mean it should err in this one.

It is recognized that, since *Shoe Corp. of America v. The Juvenile Shoe Corp. of America*, 46 CCPA 868,

266 F.2d 793, the Court of Customs and Patent Appeals has considered "third party" registrations in deciding questions of confusing similarity, albeit, recently, with that would seem to be a lack of ardor (see *In re Helene Curtis Industries, Inc.*, 49 CCPA 1367, 305 F.2d 492). The law in this Circuit, however, would, as noted before, appear to be as in the earlier case of *The Pepsodent Co. v. Comfort Manufacturing Co.*, 23 CCPA 1224, 83 F.2d 906.

CONCLUSION

There was no error, it is submitted, in the refusal of registration to appellant and, accordingly, the judgment below should be affirmed.

Respectfully submitted,

CLARENCE W. MOORE,
Solicitor, United States Patent Office
Attorney for Appellee.

March, 1965